

## REMARKS

### I. Claim Rejections - 35 USC §102

#### Requirements for Prima Facie Anticipation

A general definition of *prima facie* unpatentability is provided at 37 C.F.R.

§1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, the reference cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to

grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

***Kato***

The Examiner rejected claims 1, 2, 9-11, 14-17, 20, 21, 28-30 and 33-36 under 35 U.S.C. §102(e) as being anticipated by Kato (U.S. Patent Publication No. 2003/0103236).

Regarding claim 1, the Examiner argued that Kato discloses a print-on-demand method for creating and reproducing books by heterogeneous reproduction systems, said method comprising the steps of:

a) obtaining book files in job definition format (JDF) from at least one of a memory, scanner and network (citing FIG. 9, the local hard disk or network drive is used to store, or obtain, a book file that can be printed in the system by the local or network printer). The Examiner argued that also, the data network connecting the client PC to the document management server can be considered as the data network used to obtain book files consisting of contents related to pages and chapters of a book. The Examiner argued that the content of the book files are obtained from a computer memory in an intermediate format that includes print attributes in JDF (citing FIG. 19, paragraphs [0056]-[0062] and [0105]-[0121]). The Examiner further argued that the book files including book identification information and book production information, wherein the book files are compiled into a digital representation of a book targeted for reproduction (i.e. the application (105), citing FIG. 1) is used to issue a print request to an intermediate code generation module (106), that generates a book in coded form, which is clearly digital code since all computers operate and read digital information. The Examiner argued that the book generated in an intermediate code also contains print attribute designation data in JDF that performs the feature of determining how the print job is to be produced (e.g. double or single sided printing, etc.), which is analogous to

book production information (citing FIGS. 1, 8 and 12; paragraphs [0068]-[0075] and [0115]-[0120];

b) converting the book files from JDF into a master book embodied in common normal format (CNF) files that are reproduction system and solution-independent (arguing that the intermediate code produced from using the information regarding the original of each page and the JDF is considered by the Examiner as the common normal format since this code is independent from reproduction system and it is coded as intermediate file format data, citing paragraph [0120]);

c) storing the CNF files in memory as a mastered book (i.e. the Examiner argued that the intermediate code storage module (107) is used to store the intermediate code, considered as common normal format files, that represents the data pertaining to the book to be printed). The Examiner argued that (citing FIG. 21), the image data is stored in the intermediate code storage module before further processing for printing or producing the book, which concurs with the feature of having the files stored in memory representing the book to be printed that contains all the contents related to the book to be produced; (citing FIG. 21; paragraphs [0115]-[0120]);

d) converting the CNF files into equipment specific format files including JDF definitions that match the needs of a book reproduction system (i.e. in the system, the intermediate code generation module was used to convert the original data and the print attribute data, which is represented in JDF, into intermediate code data. The Examiner argued that this information is stored in the intermediate code memory. The Examiner argued that next, the system then obtains the intermediate code and converts the code into print data (e.g. PDL) in order for the printer to receive information in a format that is recognizable to the printer. The Examiner argued that the data converted to PDL is analogous to converting previous data into data that is specific to the printing equipment used in the system in order to match

the pre-printing requirements of the printer so that the printer is able to recognize the information and output the print data. The Examiner argued that since the intermediate data includes the JDF and the intermediate data is converted into PDL, or print data, the above feature of converting the intermediate files into equipment specified files that includes the contents of the JDF information is performed; (citing FIG. 21), paragraphs [0115]-[0120]); and

e) reproducing said book from information comprised by said book reproduction system (i.e. the local or network printers shown in FIG. 19 or the printers connected to the LAN (104) shown in FIG. 1 are considered as the book reproducers that are able to output a book from the information converted into PDL that is interpreted by the printer for printing (citing FIGS. 1, 19 and 21; paragraphs [0115]-[0120])).

The Applicant respectfully disagrees with this assessment and notes that independent claim 1 has been amended to include the following additional limitation added to step d): determining if said CNF files need to be converted into equipment specific format files based on a book reproduction system to be utilized for reproduction and if conversion is necessary, thereafter converting said CNF files into said equipment specific format files including JDF definitions that match the needs of said book reproduction system. This is disclosed in the Applicant's paragraph [0023] and in FIG. 1 as step 113. Kato does not disclose this additional limitation of *determining* if the CNF files need to be converted to ESF files.

The Applicant notes that the invention of claim 1 includes the limitations of 1) obtaining the book files in JDF format (format A), 2) converting the files into CNF format (format B), 3) storing the converted files in format B as master book files, and 4) converting the format B files into ESF format (format C). Therefore, there are *three* formats in the limitations; with the first conversion files (format B) stored as *master book* files. The Applicant's invention therefore converts the JDF files in order to create a reproduction system and solution-independent master book file

and thereafter, if needed by the reproduction system, converting to ESF format to print the book.

Kato, on the other hand, initiates only one conversion (i.e. two formats) into the equipment specific format in order to print the job. The first format is called "intermediate format" in Kato. The Examiner has argued that the *intermediate format* anticipates the Applicant's step one of obtaining the book files in JDF from memory; however, Kato does not disclose this file in JDF, but is an intermediate code containing image data such as EMF (intermediate file format data) or PDF (Kato paragraph [0120]). This intermediate format code includes print attribute designation data such as DEVMODE or JDF, but does not disclose that the intermediate format is actually JDF. Kato refers to an electronic original file and that this is also referred to as the intermediate code and also is called the book file (paragraph [0059]). These three designations in Kato are all the same file and are therefore only one file and one format. Kato does not disclose that this file, no matter what it is called is in JDF format. Therefore, Kato fails to disclose the Applicant's step a) of obtaining the book files in JDF.

The Examiner argues that the step b) limitation of converting the JDF file into CNF is disclosed in Kato by the "intermediate format"; however, this is the same intermediate format that the Examiner has cited for the JDF files. Therefore, the Examiner has argued that the first file format is "intermediate" and thereafter argues that the second file format converted is also the "intermediate" format. There is no conversion disclosed in Kato of the format A into format B (JDF into CNF) as the Examiner has cited the *same* format in Kato for both the "before" format and the "after conversion" format, namely the "intermediate" format. Therefore, Kato fails to disclose the Applicant's step b) of converting the JDF files into CNF files.

Regarding the Applicant's step c), Kato does not disclose that the stored files are the *mastered book files*, as in the Applicant's claim 1.

Therefore, Kato does not disclose the steps of: 1) determining if the CNF files need to be converted into equipment specific format files; 2) generating the book files in *JDF*; 3) converting the *JDF* files into CNF files; or 4) storing the CNF files as a mastered book.

Therefore Kato fails in the aforementioned *prima facie* anticipation test as each and every limitation of the Applicant's claim 1 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §102(e) rejection of claim 1 based on the Kato reference be withdrawn.

Regarding claim 2, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein said book in step a) is originally in the form of electronic files (i.e. the file stored in the system is converted into an electronic file in the system; (citing paragraph [0053]).

Regarding claim 9, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued Kato discloses the method in claim 1, wherein step d) comprises the step of: acquiring or generating hard copy book production information (i.e. when the system produces information related to the print attribute of the print job, this is considered as producing or generating hard copy book production information since this information informs the system about the manner in which to print the document. The Examiner argued that this information is created by the bookbinding application (1040); (citing paragraph [0058]).

Regarding claim 10, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the method in claim 9, wherein said book production information includes information pertaining to the printing information used by the printing equipment in the system; (citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120]).

Regarding claim 11, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the method in claim 9, wherein said book production information comprises printing information (i.e. the book printing attribute information includes information pertaining to the binding information used by the equipment that will perform the book binding operation; (citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120]).

Regarding claim 14, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein step d) further comprises the step of; acquiring or generating hard copy book production information (i.e. when the system produces information related to the print attribute of the print job, this is considered as producing or generating hard copy book production information since this information informs the system about the manner in which to print the document. The Examiner argued that this information is created by the bookbinding application (1040); (citing paragraph [0058]).

Regarding claim 15, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein for electronic books, said book production information comprises security information (i.e. in the system, the qualification of the user to print is checked in the system. The Examiner argued that the qualifications of the user that is checked can be considered as security information; (citing paragraph [0111]).

Regarding claim 16, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein for electronic books, said book production information comprises viewing capabilities (i.e. in the system, when opening a book file using the bookbinding application, the display methods that are designated by the user, considered as viewing capabilities, affects how the job is viewed on the display. The Examiner argued that when displaying the image data, the manner in which the book is

produced can be displayed. The Examiner argued that this is an example of the system acquiring displaying capability information from the requester of information; (citing paragraph [0112] and [0113]).

Regarding claim 17, the Examiner argued that teachings of Kato are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein for electronic books, said book production information comprises printing capabilities (i.e. in the system, when obtaining e-book creation information, which is analogous to the book production information, the printing capabilities of the requester is obtained; (citing FIGS. 1-3, paragraphs [0007]-[0023]).

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejection of independent claim 1 applies equally against the rejections of dependent claims 2, 9-11, and 14-17. As submitted above, Kato does not disclose all of the Applicant's claim 1 steps.

Therefore Kato fails in the aforementioned *prima facie* anticipation test as each and every limitation of the Applicant's claims 2, 9- 11, and 14- 17 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §102(e) rejections of claims 2, 9- 11, and 14- 17 based on the Kato reference be withdrawn.

Regarding claim 20, the Examiner argued that Kato discloses a print-on-demand system for creating and reproducing books by heterogeneous reproduction workflows, said system comprising: at least one of a scanner, memory and data network for obtaining book contents for a book targeted for reproduction (i.e. when viewing figure 19, the local hard disk or network drive is used to store, or obtain, a book file that can be printed in the system by the local or network printer. The Examiner argued that also, the data network connecting the client PC to the document management server can be considered as the data network used to obtain book files consisting of contents related to pages and chapters of a book; (citing FIG. 19; paragraphs [0056]-[0062] and [0105]-[0113]);



a book file generator adapted to generate a digital representation of said book targeted for reproduction into book files including book identification information and book production information in job definition format (JDF) (i.e. the application (105), shown in FIG. 1, is used to issue a print request to an intermediate code generation module (106), that generates a book in coded form, which is clearly digital code since all computers operate and read digital information. The Examiner argued that the book generated in an intermediate code contains information that expresses the original of each page by a detailed format, which is considered as book identification information. The Examiner argued that the intermediate code also contains print attribute designation data in JDF that performs the feature of determining how the print job is to be produced (e.g. double or single sided printing, etc.) which is analogous to book production information; (citing FIGS. 1, 8 and 12; paragraphs [0068]-[0075] and [0115]-[0120]);

a common normal format converter adapted to convert said book files into a common normal format that is reproduction system and solution-independent (i.e. the intermediate code produced from using the information regarding the original of each page and the JDF is considered as the common normal format since this code is independent from the reproduction system and it is coded as intermediate file format data; (citing paragraph [0120]);

a book file memory adapted to store common normal format files representing said book targeted for reproduction as a mastered book (i.e. the intermediate code storage module (107) is used to store the intermediate code, considered as common normal format files, that represents the data pertaining to the book to be printed. The Examiner argued that citing in FIG. 21, the image data is stored in the intermediate code storage module before further processing for printing or producing the book, which concurs with the feature of having the files stored in memory representing the book to be printed that contains all the

contents related to the book to be produced; (citing FIG. 21, paragraphs [0115]-[0120]);

an equipment specific format file converter adapted to convert common normal format files into a equipment specific format files including JDF definitions matching the needs of a book reproduction equipment being utilized to reproduce the book (i.e. in the system, the intermediate code generation module was used to convert the original data and the print attribute data, which is represented in JDF, into intermediate code data. The Examiner argued that this information is stored in the intermediate code memory. The Examiner argued that next, the system then obtains the intermediate code and converts the code into print data (e.g. PDL) in order for the printer to receive information in a format that is recognizable to the printer. The Examiner argued that the data converted to PDL is analogous to converting previous data into data that is specific to the printing equipment used in the system in order to match the pre-printing requirements of the printer so that the printer is able to recognize the information and output the print data. The Examiner argued that since the intermediate data includes the JDF and the intermediate data is converted into PDL, or print data, the above feature of converting the intermediate files into equipment specific files that includes the contents of the JDF information is performed; (citing FIG. 21; paragraphs [0115]-[0121]); and

a book reproducer adapted to reproduce the book from information comprised by the equipment specific format files (i.e. the local or network printers shown in FIG. 19 or the printers connected to the LAN (104) shown in FIG. 1 are considered as the book reproducers that are able to output a book from the information converted into PDL that is interpreted by the printer for printing; (citing FIGS. 1, 19 AND 21; paragraphs [0115]-[0121])).

The Applicant respectfully disagrees with this assessment and notes that claim 20 has been amended similar to method claim 1 with the additional limitation of an equipment specific format file converter adapted to determine if the common

normal format files need to be converted into equipment specific format files. Therefore the argument presented above against the rejection of claim 1 applies equally against the rejection of claim 20.

As submitted above, Kato does not disclose 1) file converter adapted to determine if the CNF files need to be converted into equipment specific format files; 2) obtaining the book files in *JDF*; 3) converting the *JDF* files into CNF files; or 4) storing the CNF files as a mastered book.

Therefore Kato fails in the aforementioned *prima facie* anticipation test as each and every limitation of the Applicant's claim 20 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §102(e) rejection of claim 20 based on the Kato reference be withdrawn.

Regarding claim 21, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein said book in step a) is originally in the form of electronic files (i.e. the file stored in the system is converted into an electronic file in the system; (citing paragraph [0053]).

Regarding claim 28, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein said equipment specific format converter comprises; a book production information generator adapted to generate hard copy book production information (i.e. when the system produces information related to the print attribute of the print job, this is considered as producing or generating hard copy book production information since this information informs the system about the manner in which to print the document. The Examiner argued that this information is created by the bookbinding application (1040); (citing paragraph [0058]).

Regarding claim 29, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the system in claim 28, wherein said book production information comprises printing equipment information

(i.e. the book printing attribute information includes information pertaining to the printing information used by the printing equipment in the system; (citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120]).

Regarding claim 30, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the system in claim 28, wherein said book production information comprises binding equipment information (i.e. the book printing attribute information includes information pertaining to the binding information used by the equipment that will perform the book binding operation; (citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120]).

Regarding claim 33, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein said equipment specific format converter comprises: a book production information generator adapted to generate hard copy book production information (i.e. when the system produces information related to the print attribute of the print job, this is considered by the Examiner as producing generating hard copy book production information since this information informs the system about the manner in which to print the document. The Examiner argued that this information is created by the bookbinding application (1040); (citing paragraph [0058]).

Regarding claim 34, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the system in claim 28, wherein for electronic books, said book production information comprises security information (i.e. in the system, the qualification of the user to print is checked in the system. The Examiner argued that the qualifications of the user that is checked can be considered as security information; (citing paragraph [0111]).

Regarding claim 35, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the system in claim 28, wherein for electronic books, said book production information comprises viewing capabilities (i.e. in the system, when opening a book file using the bookbinding

application, the display methods that are designated by the user, considered as viewing capabilities, affects how the job is viewed on the display. The Examiner argued that when displaying the image data, the manner in which the book is produced can be displayed. The Examiner argued that this is an example of the system acquiring displaying capability information from the requester of information; citing paragraph [0112] and [0113]].

Regarding claim 36, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein for electronic books, said book production information comprises printing capabilities (i.e. in the system, the printing attributes are related to the book file being printed is considered as the printing capabilities since these attributes define the manner in which to develop or create the book file in the printer; citing 1, 19 and 21; paragraphs [0068]-[0075] and [0120]).

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejection of independent claim 20 applies equally against the rejections of dependent claims 21, 28-30, and 33-36.

Therefore Kato fails in the aforementioned *prima facie* anticipation test as each and every limitation of the Applicant's claims 21, 28-30, and 33-36 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §102(e) rejections of claims 21, 28-30, and 33-36 based on the Kato reference be withdrawn.

## II. Claim Rejections - 35 USC §103

### Requirements for Prima Facie Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the Examiner of a *reason* to combine the references, an

applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

***Kato in view of Warmus et al.***

The Examiner rejected claims 3, 12, 13, 22, 31 and 32 under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Warmus (U.S Patent No. 6,332,149).

Regarding claim 3, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the system in claim 1, wherein said book in step a) is originally in the form of a hard copy, and step a) further comprises the steps of: scanning the components of said book; and converting scanned components of said book into said digital representation.

The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses wherein said book in step a) is originally in the form of a hard copy, and step a) further comprises the steps of: scanning the components of said book (i.e. in the system, a scanner can be used to scan an input copy, citing Warmus col. 8, lines 8-30); and converting scanned components of said book into said digital representation (i.e. the Examiner argued that like Kato, the invention of Warmus involves printing information that are related to book files and reproducing the book file information). The Examiner argued that with the scanning of an input copy and producing a movie or some non-static information, the conversion of scanned information into a movie or other non-static information is understood to be in a digital representation; (citing Warmus col. 8, lines 8-30).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the

feature of wherein said book in step a) is originally in the form of a hard copy, and step a) further comprises the steps of: scanning the components of said book and converting scanned components of said book into said digital representation in order to have a scanner which scans an input copy (citing Warmus, col. 8, lines 8-10).

Regarding claim 12, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein in step d) further comprises the step of: via a Processor, creating a bitmap of the book block (i.e. in the system, the electric original writer (1020) creates a bitmap representation of the book block; (citing FIG. 17, paragraph [0082]).

The Examiner admitted that however, Kato fails to teach Raster Image Processor. The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses Raster Image Processor (i.e. like Kato, the invention of Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that Warmus discloses having a RIP Raster Image Processor) used to create bitmaps of book pages that can be displayed; (citing FIG. 6, col. 8, lines 63-67, col. 9, lines 45-61).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a Raster Image Processor creating a bitmap of the book block in order to have a display device display pages (citing Warmus, col. 7, lines 24-31).

Regarding claim 13, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the method in claim 1, wherein step d) further comprises the step of: via a Processor, creating a bitmap of the book cover (i.e. in the system, the electric original writer (1020) creates a bitmap representation of the book block; (citing FIG. 17, paragraphs [0070] and [0082]).



The Examiner admitted that however, Kato fails to teach Raster Image Processor. The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that Warmus disclosed having a RIP used to create bitmaps of book pages, which includes cover pages, which can be displayed; (citing FIG. 6, col. 8, lines 63-67, col. 9, and lines 45-61).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a RIP creating a bitmap of the book cover in order to have display device display pages (citing Warmus, col. 7, lines 24-31).

Regarding claim 22, the Examiner argued that the teachings of Kato are disclosed above. The Examiner admitted that however, Kato fails to teach the system in claim 20, wherein said book in step a) is originally in the form of a hard copy, and said book file generator further comprises: a book scanner adapted to scan the components of said book; and a scanned component converter adapted to convert scanned components of said book into said digital representation.

The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses wherein said book in step a) is originally in the form of a hard copy, and said book file generator further comprises: a book scanner adapted to scan the components of said book (i.e. in the system, a scanner can be used to scan an input copy; (citing col. 8, lines 8-30); and a scanned component converter adapted to convert scanned components of said book into said digital representation (the Examiner argued like Kato, the invention of Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that with the scanning of an input copy and producing a movie or some non-static information, the conversion of scanned information into a movie or other non-static information, the

conversion of scanned information into a movie or other non-static information is understood to be in a digital representation; (citing Warmus col. 8, lines 8-30).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a book scanner adapted to scan the components of said book; and a scanned component converter adapted to convert scanned components of said book into said digital representation in order to have a scanner which scans an input copy (citing Warmus, col. 8, lines 8-10).

Regarding claim 31, the Examiner argued that the teachings of Kato are disclosed above. The Examiner argued that Kato discloses the system in claim 20, wherein said equipment specific format converter comprises: a Processor adapted to create a bitmap of the book block (i.e. in the system, the electric original writer (1020) creates a bitmap representation of the book block; (citing FIG. 17, paragraph [0082])).

The Examiner admitted that however, Kato fails to teach Raster Image Processor.

The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses Raster Image Processor (i.e. like Kato, the Examiner argued the invention of Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that Warmus discloses having a RIP (Raster Image Processor) used to create bitmaps of book pages that can be displayed; (citing FIG. 6; col. 8, lines 63-67, col. 9, lines 45-61).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a Raster Image Processor adapted to create a bitmap of the book block in order to have a display device display pages (citing Warmus, col. 7, lines 24-31).

Regarding claim 32, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner argued that Kato discloses the system in claim 20, wherein step d) further comprises the step of: a Processor adapted to create a bitmap of the book cover (i.e. in the system, the electric original writer (1020) creates a bitmap representation of the book block; (citing FIG. 17; paragraphs [0070] and [0082]).

The Examiner admitted that however, Kato fails to teach Raster Image Processor.

The Examiner argued that however, this is well known in the art as evidenced by Warmus. The Examiner argued that Warmus discloses Raster Image Processor (i.e. like Kato, the invention of Warmus involves printing information that are related to book files and reproducing the book file information. The Examiner argued that Warmus discloses having a RIP (Raster image processor) used to create bitmaps of book pages, which includes cover pages, which can be displayed: citing FIG. 6; col. 8, lines 63-67, col. 9, lines 45-61).

The Examiner argued that therefore, in view of Warmus, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of a Raster Image Processor adapted to create a bitmap of the book cover in order to have a display device display pages (citing Warmus, col. 7, lines 24-31).

The Applicant respectfully disagrees with this assessment and notes that the arguments presented above against the rejection of claim 1 and 20 applies equally against the rejections of claims 3, 12, 13, 22, 31 and 32. Kato in view of Warmus does not disclose 1) a file converter adapted to determine if the CNF files need to be converted into equipment specific format files; 2) obtaining the book files in JDF; 3) converting the JDF files into CNF files; or 4) storing the CNF files as a mastered book.

Additionally, the U.S. Supreme Court has expressly instructed that it remains legally insufficient to conclude that a claim is obvious just because each feature of the claim can be independently shown in the prior art (KSR opinion page 14). The Court has additionally required that the Examiner provide some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness. This reason to combine the references should include a detailed explanation of the *effects of demands known to the design community* or present in the marketplace and the *background knowledge* possessed by a person of ordinary skill in the art. Anything less than such a rationale reason may not be sufficient to support a *prima facie* case of obviousness. The Examiner has not provided such a rationale reason for combining the Kato and Warmus references.

Therefore, Kato in view of Warmus fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claims is not disclosed. Furthermore, the Examiner has not provided an explicit rationale to combine the references. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C §103(a) rejections of claims 3, 12, 13, 22, 31 and 32 based on Kato in view of Warmus.

***Kato in view of Clark et al.***

The Examiner rejected claims 4-8, 18, 19, 23-27, 37 and 38 under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Clark (U.S. Patent Publication No. 2002/0152215).

Regarding claim 4, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach disclose the method in claim 1, wherein said book identification information comprises the book title.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification

information comprises the book title (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs {0022}-[0025]). The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraph s [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book title in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 5, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the method in claim 1, wherein said book identification information comprises the book author (i.e. in the system, book identification information includes an author; (citing FIGS. 1-3; paragraphs [0007]-[0023]).

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book author (the Examiner argued that, i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]). The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the

eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book author in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 6, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the method in claim 1, wherein said book identification information comprises the book publisher.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book publisher (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs {0022}-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown in FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number an publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book publisher in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 7, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the method in claim 1, wherein said book identification information comprises the International Standard Book Number (ISBN).

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the ISBN (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022][0025]). The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the ISBN in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 8, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the method in claim 1, wherein said book identification information comprises the book publishing date.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book publishing date (i.e. the reference of Clark offers a

print-on-demand titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025]). The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book publishing date in order to obtain information on eBooks or "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book publishing date in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 18, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the method in claim 1 wherein step e) comprises for electronic books, the step of: providing access to said book via an electronic link to a data network.

The Examiner argued that, however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein step e)



comprises for electronic books, the step of: providing access to said book via an electronic link to a data network (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that during the process of fulfilling a purchase request, a URL, or a link, is sent to the user to provide access to the purchased eBook; (citing FIG. 16; paragraphs [0068]-[0074]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of an providing access to said book via an electronic link to a data network in order to enable a consumer "print-on-demand" hard copies of a title (citing Clark, paragraph [0069]).

Regarding claim 19, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the method in claim 1 wherein step e) comprises for electronic books, the step of: delivering said book to a predefined destination.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein step e) comprises for electronic books, the step of: delivering said book to a predefined destination (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that during the process of fulfilling a purchase request, a URL, or link, is sent to the user to provide access to the purchased eBook. The Examiner argued that the user then receives the eBook from the server (210) that handles distribution of the eBook. The Examiner argued that the feature of a link delivering a book to the predefined destination (e.g. the consumer client computer (208) over a data network (202); (citing FIG. 16-18; paragraphs [0068]-[0077]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein step e) comprises for electronic books, the step of: delivering said book to a predefined destination in order to enable a consumer "print-on-demand" hard copies of title (citing Clark, paragraph [0069]).

Regarding claim 23, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the system in claim 20, wherein said book identification information comprises the book title.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book title (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date: (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book title in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 24, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the system in claim 20, wherein said book identification information comprises the book author.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book author (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book author in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 25, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach discloses the system in claim 20, wherein said book identification information comprises the book publisher.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprised the book publisher (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that the

publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book identification information comprises the book publisher in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 26, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the method in claim 20, wherein said book identification information comprises the ISBN.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the ISBN (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022][0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that shown on FIG. 6 is an example of a publisher creating information related to the eBooks and "print-on-demand" titles that the publisher offers. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing paragraphs [0022]-[0025] and [0033]-[0038]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the

feature of wherein said book identification information comprises the ISBN in order to obtain information on eBooks or "print-on-demand" titles offered on the network (citing Clark, paragraph [0035]).

Regarding claim 27, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the system in claim 20, wherein said book identification information comprises the book publishing date.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book identification information comprises the book publishing date (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that the publishing client (204) is used to submit information identifying a book that includes a title, author and ISBN. The Examiner argued that the information offered includes the publisher, publisher reference number and publication date; (citing Clark, paragraph [0035]).

Regarding claim 37, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the system in claim 20 wherein said book reproducer comprises for electronic books: an electronic link adapted to provide access to said book.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book reproducer comprises for electronic books: an electronic link adapted to provide access to said book (9.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that during the process of fulfilling a purchase

request, a URL, or link, is sent to the user to provide access to the purchased eBook; (citing FIG. 16, paragraphs [0068]-[0074]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of an electronic link adapted to provide access to said book in order to enable consumer "print-on-demand" hard copies of a title (citing Clark, paragraph [0069]).

Regarding claim 38, the Examiner argued that the teachings of Kato are disclosed above.

The Examiner admitted that however, Kato fails to teach the system in claim 20 wherein said book reproducer comprises for electronic books: an electronic link adapted to deliver said book to a predefined destination over a data network.

The Examiner argued that however, this is well known in the art as evidenced by Clark. The Examiner argued that Clark discloses wherein said book reproducer comprises for electronic books: an electronic link adapted to deliver said book to a predefined destination over a data network (i.e. the reference of Clark offers a print-on-demand system similar to the reference of Kato. The Examiner argued that this is mentioned in paragraphs [0022]-[0025]. The Examiner argued that during the process of fulfilling a purchase request, a URL, or link, is sent to the user to provide access to the purchased eBook. The Examiner argued that the user then receives the eBook from the server (210) that handles distribution of the eBook. The Examiner argued that the feature of the server delivering the eBook to the consumer performs the feature of a link delivering a book to the predefined destination (e.g. the consumer client computer (208) over a data network (202); (citing FIGS. 16-18; paragraphs [0068]-[0077]).

The Examiner argued that therefore, in view of Clark, it would have been obvious to one of ordinary skill at the time the invention was made to have the feature of wherein said book reproducer comprises for electronic books: an

electronic link adapted to deliver said book to a predefined destination over a data network in order to enable a consumer "print-on-demand" hard copies of a title (citing Clark, paragraph [0069]).

The Applicant respectfully disagrees with this assessment and notes that the arguments presented above against the rejection of claim 1 and 20 applies equally against the rejections of claims 4-8, 18, 19, 23-27, 37 and 38. Kato in view of Clark does not disclose 1) a file converter adapted to determine if the CNF files need to be converted into equipment specific format files; 2) obtaining the book files in *JDF*; 3) converting the *JDF* files into CNF files; or 4) storing the CNF files as a mastered book.

Additionally, the Examiner has not provided a rationale reason for combining the Kato and Clark references in accordance with the U.S. Supreme Court ruling, as submitted above.

Therefore, Kato in view of Clark fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claims 4-8, 18, 19, 23-27, 37 and 38 is not disclosed. Furthermore, the Examiner has not provided an explicit rationale to combine the references. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C §103(a) rejections of claims 4-8, 18, 19, 23-27, 37 and 38 based on Kato in view of Clark.

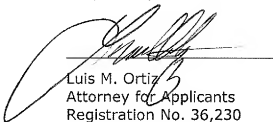
**III. Conclusion**

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §102 and §103 based on the preceding remarks. Reconsideration and allowance of Applicant's claims is also respectfully solicited. A Request for Continued Examination (RCE) under 37 CFR 1.114 is also submitted herewith, including the RCE fee of \$810.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

Dated: September 23, 2008

A handwritten signature in black ink, appearing to read 'Luis M. Ortiz', is written over a horizontal line.

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